

## REMARKS

- Claims 1-4, 6-10, 12-24 and 31-34 are pending
- Claims 1, 31 and 33 have been amended
- Claims 5, 17 and 25-30 have been cancelled
- Claims 1, 31, 33, and 34 are independent claims

### A. SECTION 101 REJECTION

Claims 1, 3-10 and 22-34 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter for failing to provide a “concrete result.” [Current Office Action, page 3]. The Examiner has indicated that “[a]lthough a determination is made regarding the hand or a plurality of hands of blackjack, the result is never functionally used or displayed.” Id.

While Applicants disagree with the Examiner’s rejection of the claims, Applicants have amended independent Claims 1 and 31 to incorporate matter from cancelled claim 5. As amended, Claims 1 and 31 include the limitation *displaying an indication of the random outcome to the player*.

Claim 33 has been amended to include the limitation, *transmitting, via communication network, a random outcome in response to said receiving, the random outcome determining if the player has won the hand of blackjack*.

Applicants assert that the amendments to the above claims provide a “concrete result” under Section 101.

Regarding the Examiner’s rejection of Claim 34, Applicants respectfully request reconsideration and withdrawal of the instant rejection as the claim comports with an example provided by the Examiner of a “concrete result.” Namely, a limitation of Claim 34 requires *displaying to the player an indication of at least one of (i) the random outcome and (ii) the determination if the player has won the hand of blackjack* (emphasis added).

Applicants intend to seek claims in subsequent continuing applications directed to the original subject matter and pursue the instant claims without prejudice or disclaimer.

**B. SECTION 112 REJECTION**

The Examiner has rejection Claims 1-10 and 12-24 “under Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” [Current Office Action, page 4]. Specifically, the Examiner states that “[i]n regards to claim 1, the language of ‘generating an additional random outcome’ is vague and indefinite because an initial random outcome or a first random outcome must take place before a second or additional random outcome occurs.” Id.

Claim 1 includes limitations directed to:

*playing a hand in a game of blackjack, which includes  
dealing a first set of accumulated cards to a player, and  
dealing a second set of accumulated cards to a dealer*

Applicants assert that the claim language, *generating an additional random outcome*, is neither vague nor indefinite as an initial random outcome has been generated by *dealing a first set of accumulated cards to a player, and dealing a second set of accumulated cards to a dealer*. As such, Applicants respectfully request reconsideration and withdrawal of the instant rejection.

**C. SECTION 102(e) REJECTION**

Claim 33 stands rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,803,461 issued to Hesse (“Hesse”). We respectfully traverse the Examiner’s Section 102(b) rejection.

**1. Independent Claim 33**

We respectfully submit that Claim 33 is not anticipated by Hesse. Hesse does not teach or suggest all of the features of independent Claim 33.

**(a) Hesse Does Not Disclose All the Limitations of Independent Claim 33**

As best understood by us, the Examiner asserts the following to be true with respect to independent Claim 33:

Hesse discloses:

- *receiving an indication that the hand of blackjack has resulted in a push*
- *transmitting, via a communication network, a random outcome in response to said receiving, the random outcome determining if the player has won the hand of blackjack*

We respectfully traverse these assertions. We have carefully reviewed the Hesse reference cited by the Examiner, without finding a teaching or suggestion of *receiving an indication that the hand of blackjack has resulted in a push*, much less *transmitting, via a communication network, a random outcome in response to said receiving, the random outcome determining if the player has won the hand of blackjack*.

Independent Claim 33 recites *receiving an indication that the hand of blackjack has resulted in a push*. Various embodiments of the present invention are directed to

when a blackjack hand between the dealer 10 and a player 20 results in a push (e.g., both accumulated cards having a total of nineteen), the dealer 10 may activate the dealer input device 14 on the dealer device 12. The dealer device 12 may then, for example, communicate with the controller 200 to request a random outcome. The controller 200 may transmit an indication of the random outcome to the dealer device 12, which in turn displays the random outcome via the dealer output device 16

[Specification, page 5, lines 4-10.]

In contrast, and contrary to the Examiner's assertion, Hesse is devoid of any hint or suggestion of *receiving an indication that the hand of blackjack has resulted in a push* or *transmitting, via a communication network, a random outcome in response to said receiving, the random outcome determining if the player has won the hand of blackjack*, as recited in independent Claim 33. Applicants have carefully reviewed Hesse without finding a teaching or suggestion of “receiving an indication (verbal)” or “transmitting (verbally)” as asserted by the Examiner, let alone *transmitting, via a communication network*. [Current Office Action, page5].

As such, Applicants respectfully assert that the Examiner has failed to establish a *prima facie* case of anticipation with respect to Claim 33. Accordingly, Applicants request withdrawal of the rejection.

**D. SECTION 103(a) REJECTIONS****1. Claims 1-10, 12-24 and 34**

Claims 1-10, 12-24 and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hesse, and further in view of U.S. Patent No. 5,362,064 issued to Feola (hereinafter "Feola"). We respectfully traverse the Examiner's Section 103(a) rejection.

**a. The Examiner has Failed to Meet the Basic Criteria for  
*Prima Facie* Obviousness**

The Examiner has failed to make the requisite factual findings required under Graham and thus cannot factually support a *prima facie* conclusion of obviousness with respect to any claim.

For example, without resolving the level of ordinary skill in the art, the Examiner has no factual support for an assertion that either (a) a claimed feature or (b) a motivation to combine / modify references may be found objectively either (i) in the references themselves, (ii) in the knowledge generally available to one of ordinary skill in the art, or (iii) in the nature of the problem to be solved.

In addition, the Examiner has failed to make any assertion of a reasonable expectation of success with respect to any claim.

For at least these reasons, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for any pending claim.

**No Motivation to Combine the Cited References**

As best understood by us, the Examiner also asserts the following to be true with respect to Claims 1-10, 12-24 and 34:

- (a) It would have been obvious to one of ordinary skill in the art to modify Hesse in light of Feola to provide for a feature of *[the] random outcome [being] statistically independent of [the] hand of blackjack played prior to [the] push*
- (b) The motivations for this modification above would be to provide definite unbiased game result.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 706.02(j). In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992).

In view of the above, the Examiner must show that the prior art of record provides the motivation of (b) above. MPEP 2143. Further, the Examiner must show that the asserted subject matter of (b) above includes a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art to produce the specific features of the claimed invention.

**(i) The Asserted Motivation is Not Shown in the Cited References**

We have carefully reviewed the Office Action issued in the present application, as well as the Hesse and Feola references cited by the Examiner, without finding a motivation anywhere in the record that suggests the desirability of combining or modifying the cited references in the manner proposed by the Examiner.

The Examiner does not assert otherwise. The Examiner's statement thus amounts to no more than a conclusory statement of a generalized advantage (a "providing a definite unbiased game result") and an unsupported allegation about what was known to those of ordinary skill.

**(ii) The Asserted Motivation Does Not Suggest the Desirability of *[the] random outcome [being] statistically independent of [the] hand of blackjack played prior to [the] push***

Further, the motivation as asserted by the Examiner, would not suggest the desirability of modifying the "Newjack" game system of Hesse to provide specifically for the feature of *[the] random outcome [being] statistically independent of [the] hand of blackjack played prior to [the] push*, as recited in independent Claims **1** and **34**. The Examiner does not provide any reasoning or support in the evidence of record as to why the asserted desirability of providing a definite unbiased game result, would specifically

suggest to one of ordinary skill in the art the desirability of provide for *[the] random outcome [being] statistically independent of [the] hand of blackjack played prior to [the] push* in the Hesse system to meet any of the asserted desirable objectives.

Accordingly, the asserted motivation in Feola reference amounts to a mere statement by the Examiner that the proposed combination or modification would be advantageous. This statement does not meet the requirement of evidence of a motivation in the prior art to combine the particular asserted teachings in the manner proposed by the Examiner. We respectfully submit that the purported motivations do not suggest any such modification of the Hesse system.

Also, the asserted motivation of including a “rotating wheel a[sic] generating outcome” ...to provide definite [sic] unbiased game result does not suggest the desirability of *[the] random outcome [being] statistically independent of [the] hand of blackjack played prior to [the] push*, much less a motivation for modifying the system of Hesse. In fact, Feola describes “a game wherein a plurality of distinct random value selectors are utilized to obtain separate values which are both considered, e.g. compared. Players are provided with at least one and preferably a plurality of possible outcomes upon which to wager.” [Column 2, lines 21-26.] Feola discloses a game where a player may place a wager upon a wheel or cards, and may win or lose depending on the value of one compared to the other. [Column 3, lines 16-41].

It is not clear to us how Feola's description of a game where a player may place a wager upon a wheel or cards suggests either a motivation to provide for definite unbiased game result or a motivation to modify the system of Hesse; we respectfully request clarification of the Examiner's reasoning.

We respectfully submit that there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of independent Claims 1 and 34. Accordingly, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of independent Claims 1 and 34.

If, on the other hand, our understanding of what the Examiner is asserting to be true is incorrect, we request clarification of the above so that the present application may proceed to allowance or appeal.

## 2. Claims 31-32

Claims 31-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hesse, and further in view of U.S. Patent No. 5,954,335 issued to Moody (hereinafter “Moody”). We respectfully traverse the Examiner’s Section 103(a) rejection.

### a. Independent Claim 31

We respectfully submit that independent Claim 31 is not obvious in light of Hesse or Moody, either alone or in combination. First, no combination of Hesse and Moody teaches or suggests all of the features of independent Claim 31.

Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of independent Claim 31.

Claim 31 has been amended to include the limitation *the random outcome is statistically independent of the first hand and the second hand of blackjack played prior to the first push and second push*. As discussed above, with respect to the rejection of Claims 1-10, 12-24 and 34, Hesse fails to teach that *the random outcome is statistically independent of the hand of blackjack played prior to the push*. In fact, Hesse teaches the opposite:

One additional option [in the case of a “push”] is to have a second contest to decide the winner if both parties go over the target. For example, each party could draw one additional card.

Column 6, lines 9-11. As such, Hesse arguably teaches method of resolving a push that is ***statistically dependent*** as drawing an additional card from the deck will both 1) change the statistical probabilities of resolving the “push” as card are removed from the deck or “shoe”, and 2) subsequently affect the statistical probabilities of any following hand. Consequently, any combination of Hesse and Moody fails to teach *the random outcome is statistically independent of the first hand and the second hand of blackjack played prior to the first push and second push*.

Further, neither Hesse nor Moody teach or suggest the limitation *based on a random outcome, determining if the player has won the first and second hands of blackjack.* (emphasis added). Moody arguably teaches a method of playing a plurality of hands of blackjack utilizing the pair of cards initially dealt in each hand. See Abstract. However, neither Hesse nor Moody teach or suggest resolving a plurality of blackjack hands resulting in a push with a single random outcome. The Examiner does not assert otherwise.

### **No Motivation to Combine the Cited References**

As best understood by us, the Examiner also asserts the following to be true with respect to Claims 31-32:

- (a) It would have been obvious to one of ordinary skill in the art to modify Hesse in light of Moody to provide for a feature of *the second hand of blackjack is played after the first hand of blackjack is played*
- (b) The motivations for this modification above would be to provide game players multiple opportunities to win whenever good hands are achieved.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 706.02(j). In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992).

In view of the above, the Examiner must show that the prior art of record provides the motivation of (b) above. MPEP 2143. Further, the Examiner must show that the asserted subject matter of (b) above includes a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art to produce the specific features of the claimed invention.



**(i) The Asserted Motivation is Not Shown in the Cited References**

We have carefully reviewed the Office Action issued in the present application, as well as the Hesse and Moody references cited by the Examiner, without finding a motivation anywhere in the record that suggests the desirability of combining or modifying the cited references in the manner proposed by the Examiner.

The Examiner does not assert otherwise. The Examiner's statement thus amounts to no more than a conclusory statement of a generalized advantage (a "providing game players multiple opportunities to win whenever good hands are achieved") and an unsupported allegation about what was known to those of ordinary skill.

**(ii) The Asserted Motivation Does Not Suggest the Desirability of 1) *[the] random outcome [being] statistically independent of [the] hand of blackjack played prior to [the] push* or 2) *based on a random outcome, determining if the player has won the first and second hands of blackjack***

Further, the motivation as asserted by the Examiner, would not suggest the desirability of modifying the "Newjack" game system of Hesse to provide specifically for the feature of *[the] random outcome [being] statistically independent of [the] hand of blackjack played prior to [the] push or based on a random outcome, determining if the player has won the first and second hands of blackjack*, as recited in independent Claims 32. The Examiner does not provide any reasoning or support in the evidence of record as to why the asserted desirability of providing game players multiple opportunities to win whenever good hands are achieved, would specifically suggest to one of ordinary skill in the art the desirability of provide for *[the] random outcome [being] statistically independent of [the] hand of blackjack played prior to [the] push or based on a random outcome, determining if the player has won the first and second hands of blackjack* in the Hesse system to meet any of the asserted desirable objectives.

Accordingly, the asserted motivation in Moody reference amounts to a mere statement by the Examiner that the proposed combination or modification would be advantageous. This statement does not meet the requirement of evidence of a motivation in the prior art to combine the particular asserted teachings in the manner proposed by the Examiner. We respectfully submit that the purported motivations do not suggest any such modification of the Hesse system.

It is not clear to us how Moody's description of a game where a player may play a plurality of hands of blackjack utilizing the pair of cards initially dealt in each hand suggests a motivation to modify the system of Hesse; we respectfully request clarification of the Examiner's reasoning.

Further, Applicants assert that even if the motivation stated by the Examiner were present in Moody to modify Hesse in the manner suggested, the resulting modification would fail to yield Applicants' invention. As stated above, neither reference teaches or suggests, alone or in combination, *[the] random outcome [being] statistically independent of [the] hand of blackjack played prior to [the] push or 2) based on a random outcome, determining if the player has won the first and second hands of blackjack*. Nor does the motivation to combine the references provided by Examiner yield either of the above limitations.

We respectfully submit that there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of independent Claims 32. Accordingly, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of independent Claims 32.

If, on the other hand, our understanding of what the Examiner is asserting to be true is incorrect, we request clarification of the above so that the present application may proceed to allowance or appeal.

CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Jason Skinder at telephone number 203-461-7017 or via electronic mail at [jskinder@walkerdigital.com](mailto:jskinder@walkerdigital.com).

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